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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,159	08/07/2003	Ernest R. Chacon	13710-4001	3580
34313	7590	12/21/2006	EXAMINER	
ORRICK, HERRINGTON & SUTCLIFFE, LLP			CHU, HELEN OK	
IP PROSECUTION DEPARTMENT			ART UNIT	PAPER NUMBER
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	12/21/2006		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/638,159	CHACON, ERNEST R.
	Examiner	Art Unit
	Helen O. Chu	1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 October 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 7-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 7-22 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Applicant's Amendments have been received on October 6, 2006. Claims 7-12 are amended. Claims 13-22 are new claims.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action.

Drawings

The drawing objections are withdrawn.

Claim Rejections - 35 USC § 112

3. The rejections under 35 U.S.C 112, second paragraph on claims 7 and 8 are withdrawn because Applicant has amended the claims
4. The rejections under 35 U.S.C 112, second paragraph on claims 7 and 8 are withdrawn because the Applicant has amended the claims.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 7, 8 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "batteries of known dimensions" is used in the claims, however, in the specification the inventor uses cylindrical batteries. The Examiner can interpret this claim as for different shapes and different measurements of a battery. For instance, the measurements such as a AAA battery is

not known to the Examiner without further conducting research. Therefore, the claim recitation of the battery invention with "known dimensions" is not valid.

Claims 13 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "batteries are accessible to a user for any purpose" is used in the claims, however, in the specification the inventor uses cylindrical batteries. The claimed recitation "batteries are accessible to a user for any purpose" is unclear to the Examiner. The recitation "batteries are accessible to a user for any purpose" can mean unlimited amounts of possibilities. For instance, the battery case and lid of Takeno et al. reference can be fixed together by screws (Column 9, Lines 9-15), the batteries are still accessible to one of ordinary skill in the art because one would have to unscrew the screws to gain access. Further, once gained access to the batteries, one skilled in the "hammer art" can use these batteries as a hammer or one skilled the "screw driver art" can use these batteries to try to screw in the screws to tighten the container. The rejection to the claim limitation will not be held in abeyance.

Claims Analysis

7. The structures of the claim limitation are given patentable weight, however, the functional claim language is not given patentable weight. Some examples of functional claim language includes:

Claim 7 Part C: "for removal from the battery storage apparatus for use in a device requiring batteries."

Claims 9, 10, 18 and 19; "allows easier insertion and removal of the battery"

Claims 11, 12, 20, and 21 "thereby impeding contact with a battery terminal to prevent accidental discharge"

Claims 14; " allows retrieval of said battery"

Claim Rejections - 35 USC § 102

8. The rejections under 35 U.S.C 102(b), on claims 7-12, as anticipated by Takeno et al. are maintained. The rejection is repeated below for purposes of convenience.
9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 7-12, 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeno et al. (US Patent 6,428,925).

In regard to claims 7, 8 and 14-17, the Takeno et al. reference illustrates a battery storage apparatus with polycarbonate (Applicant's material for non-conductivity; Column 6, Lines 22-23) first and second sleeves which are closed on one end and opened on the other end (Figure 9). The sleeves comprise of two cavities (Figure 18), which are closed on one end and opened on the other (Figure 15). The Takeno et al. reference also illustrates the length of the bottom sleeve is approximately the length of the exposed batteries and the length of the top sleeve is shorter than length of the

batteries (Figure 15, Column4, lines 15-28). Furthermore, the Takeno et al. reference discloses that the battery case may be made in half as each battery cell and a battery pack may be constructed using a lid that has the same shape as the case.

In regards to claims 9,10, 18, 19, the Takeno et al discloses air apertures that pass through the first and second sleeve (Figure 2, Component 6; Figure 9, Component 44; Column 5, Lines 11-19)).

In regard to claims 11, 12, 20, 21, the Takeno et al. further illustrates in Figure 3 that the diameter of the battery terminal (Component 21; Column 11, lines 4-5) is larger than the diameter of the air aperture (Component 6).

Claim Rejections - 35 USC § 103

11. The rejections under 35 U.S.C 103(a), on claims 7-12, as unpatentable by Nishiyama et al. are maintained. The rejection is repeated below for purposes of convenience.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama et al. (US Patent 6,174,618).

13. The Nishiyama et al. reference discloses a battery holder made of ABS resin (Applicant's material for non-conductivity; Column 3, Lines 51) first and second sleeves, which have a closed end and opened on the other end (Figure 8). The sleeves comprise of cavities (Figure 8), which have a closed end and opened on the other (Figure 8). The Nishiyama et al illustrates the diameter of the air apertures that pass through the first and second sleeve (Figure 1, Component 2d) are smaller than the diameters of the battery terminals (Figure 1, Component 2b). Though, the Nishiyama et al. reference disclose the claimed invention except for the length of one sleeve to be approximately the length of the exposed battery, it would have been obvious matter of design choice to make the length of the battery holder longer so that it would protect the battery, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *MPEP 2144.04 (IV)*.

Response to Arguments

14. Applicant's arguments filed 10/6/2006 have been fully considered but they are not persuasive.

The Applicant's principal arguments are:

A) Election/Restriction requirement arguments

B) Applicant respectfully submits that the specification does not in any way limit the non-conductive material to polycarbonate. Instead the Applicant identifies polycarbonates as an example of a non-conductive material.

C) The Takeno et al. reference is a battery pack to power tools, or to be safely charged, both in a manner that controls the rise in temperature associated with each.

D) Takeno et al. is not an air aperture to a sleeve or anything else-it is a hollow space. Its function is to allow cooling of the batteries during charging and use.

E) Instead, the Nishiyama et al. reference is directed to a battery holder whereby the sides of the batteries are substantially exposed in order to help dissipate heat generated by charging and discharging the batteries.

In response to Applicant's arguments, please consider the following:

A) Regarding the Election/Restriction, the Examiner had made this Final.

However, the Examiner will attempt to make this more concise for the Applicants understanding. First, the Examiner is confused on the basis of the Applicants arguments. The grounds for restriction on the Election/Restriction Office Action dated 4/13/2006 is between two species. The first species 1A is drawn to battery storage apparatus with one sleeve. The second species 2A is drawn to a battery storage apparatus with two sleeves. The Applicants rebutted on an Action dated 5/9/2006 arguing that that it is noted the Examiner states on Office Action 4/13/2006 that Species 2A is directed to a storage apparatus that can store "two batteries". This presents an issue because the Examiner never asked the Applicants to elect any species directed to a storage apparatus that can store "two batteries", however, the election is between two species with different amounts of sleeves and would make the storage apparatus structurally different from one another. Therefore, the Examiner had made the Election/Restriction Final on Office Action 6/6/2006 because the Applicants are not

arguing the presented species. The Examiner advises the Applicants to read the MPEP or Examiner's Office Actions more thoroughly before submitting any arguments in order to forward prosecution.

B) The polycarbonate material was addressed by the Examiner to indicate that the sleeve of the prior art is made of non-conductive material.

C) The Taneko et al. reference meets all the limitations of the claims regardless of the use intended by the invention taught by the Taneko et al. The claim limitations are directed to a "battery storage apparatus." If the Taneko et al. reference indeed states the invention is directed towards a power tool, the battery are still held within a case and lid and the case and lid are held within the power tool, hence, the case and lid or the power tool can be a battery storage apparatus.

D) An "air aperture" is interpreted by the Examiner as a hole where air can enter or leave. The Taneko et al. reference teaches the same functions presented by the Applicants. Therefore, the prior art teaches all the claim limitations as the Applicants.

E) Please look at MPEP 2144.04 (IV) as addressed by the Examiner. All of the disclosures taught by Nashiyimi meet the claim limitations of the Applicants, therefore, the invention is not novel even if the Applicants changes the size (length) of their invention.

15. Applicant's other arguments with respect to claims 7, 9-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Art Unit: 1745

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen O. Chu whose telephone number is (571) 272-5162. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HOC



TRACY DOVE
PRIMARY EXAMINER

12/06